

**REMARKS**

Favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

**Summary of the Office Action**

Claims 1 and 4-6 stand rejected under 35 U.S.C. §102(b) as being unpatentable by Nishi (U.S. Patent Publication No. 2002/0034149).

Claims 2, 3 and 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nishi.

**Summary of the Response to the Office Action**

No changes to the claims have been proposed by this response. Claims 1-17 are currently pending.

**Claim Rejections Under 35 U.S.C. §102(b)**

Claims 1 and 4-6 stand rejected under 35 U.S.C. §102(b) as being unpatentable by Nishi. This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that Nishi does not anticipate claims 1 and 4-6 because Nishi does not teach or suggest every feature of these recited claims. For instance, it is respectfully submitted that Nishi fails to disclose or suggest the claimed combination as set forth in independent claim 1 including at least “a prism made of a flint glass, onto which two or more light beams having different wavelengths are incident,” and wherein “the light beams having different wavelengths incident onto the front end surface of the prism made of a flint glass are refracted so that optical axes of the light beams coincide, and are then emitted from the rear end surface of the prism made of a crown glass.”

In addition, it is respectfully submitted that Nishi fails to teach or suggest the claimed combination as set forth in independent claim 4 including at least “a light emitting element for emitting two or more light beams having different wavelengths,” and “an achromatic prism installed at an optical route between the light emitting element and the beam splitter.”

In the rejection, the Office Action asserts that the anamorphic prism (101) as taught by Nishi corresponds to the achromatic prism as set forth in independent claims 1 and 4, and that the semiconductor laser (105) as taught by Nishi corresponds to the light emitting element as set forth in independent claim 4. However, in contrast to the claimed combinations as a whole, the arrangement of Nishi is focused on directing a single light beam emitted from a single light source onto a recording medium. In particular, Nishi discloses at paragraph [0006], lines 9-12 that “an anamorphic prism 101 as shown in FIG. 1 is designed to show a magnification of conversion of 1.9 to incident light with a wavelength of 660 nm.” In fact, no portion of Nishi’s disclosure discusses providing two or more light beams having different wavelengths or light beams having different wavelengths being incident onto the front end surface of the prism.

M.P.E.P. § 2131 states “[t]o anticipate a claim, the reference must teach every element of the claim.” Applicants respectfully submit that since Nishi does not teach or suggest every feature of independent claims 1 and 4, Nishi does not anticipate claims 1 and 4. Further, since claims 5 and 6 depend from claim 4, it is respectfully submitted that Nishi also does not anticipate claims 5 and 6. Accordingly, withdrawal of the rejection of claims 1 and 4-6 under 35 U.S.C. § 102(b) is respectfully requested.

#### **Claim Rejections Under 35 U.S.C. §103(a)**

Claims 2, 3 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishi. This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that Nishi does not render claims 2, 3 and 7-9 unpatentable, because Nishi fails to teach or suggest every feature of these recited claims. For instance, it is respectfully submitted that Nishi fails to teach or suggest the claimed combination as set forth in independent claim 2 including at least “a light emitting element for emitting two or more light beams having different wavelengths,” and “an achromatic prism installed in front of the light emitting element.” In addition, it is respectfully submitted that Nishi fails to teach or suggest the claimed combination as set forth in independent claim 7 including at least “a light emitting element module including a light emitting element for emitting two or more light beams having different wavelengths,” and “an achromatic prism installed in front of the light emitting element.”

In the rejection, the Office Action asserts that the anamorphic prism (101) and the semiconductor laser (105) as taught by Nishi respectively correspond to the achromatic prism and the light emitting element as set forth in independent claims 2 and 7. However, in contrast to the claimed combinations as a whole, the arrangement of Nishi is focused on directing a single light beam emitted from a single light source onto a recording medium. In particular, Nishi discloses at paragraph [0006], lines 9-12 that “an anamorphic prism 101 as shown in FIG. 1 is designed to show a magnification of conversion of 1.9 to incident light with a wavelength of 660 nm.” In fact, no portion of Nishi’s disclosure discusses “a light emitting element for emitting two or more light beam having different wavelengths,” and “an achromatic prism installed in front of the light emitting element... so that the light emitting element and the achromatic prism are combined into a single package,” as set forth in independent claims 2 and 7.

M.P.E.P. §2143.03 instructs that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490

F.2d 981, 180 USPQ 580 (CCPA 1974).” Since, in view of the above, Nishi fails to teach or suggest every feature of independent claims 2 and 7, it is respectfully submitted that Nishi does not render claims 2 and 7 unpatentable. Further, since claims 3 depend from claim 2 and claims 8-9 depend from claim 7, it is respectfully submitted that Nishi also does not render claims 3, 8 and 9 unpatentable. Accordingly, withdrawal of the rejection of claims 2, 3 and 7-9 under 35 U.S.C. §103(a) is respectfully requested.

### **Conclusion**

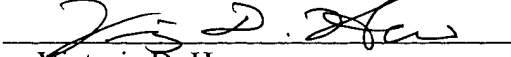
In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

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By:   
Victoria D. Hao  
Registration No. 47,630

**Customer No.: 009629**  
**MORGAN, LEWIS & BOCKIUS LLP**  
1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
Telephone: 202.739.3000  
Facsimile: 202.739.3001